

## **REMARKS**

Applicants request favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Claims 1-25 were pending in the application, of which claims 3, 12, and 14-24 were withdrawn from consideration. Claims 1, 2, 4-11, 13, and 25 were rejected in the Office Action. To expedite prosecution, claims 3, 12, and 14-25 have been cancelled, without prejudice or disclaimer. No claims have been amended and no new matter has been added.

### **1. Objection to the Specification**

The Examiner objected to the specification under 37 C.F.R. § 1.71 “because the specification fails to teach the elected species, which has cut outs (23), being ‘free from cut-out portions,’” as recited in claim 25. In response to this objection, claim 25 has been cancelled, without prejudice or disclaimer. Accordingly, the objection to the specification is now moot and should be withdrawn.

### **2. Rejection of Claim 25 under 35 U.S.C. § 112, ¶ 1**

The Examiner rejected claim 25 under 35 U.S.C. § 112, ¶ 1 “as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Specifically, the Examiner rejected claim 25 on the ground that “the specification fails to teach the elected species, which has cut outs (23), being ‘free from cut-out portions.’” In response to this rejection, claim 25 has been cancelled, without prejudice or disclaimer. Accordingly, the rejection of claim 25 under 35 U.S.C. § 112 is now moot and should be withdrawn.

### **3. Rejection of Claims 1, 2, 4-11, 13, and 25 under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1, 2, 4-11, 13, and 25 under 35 U.S.C. § 103(a) as being obvious when considering U.S. Patent No. 6,357,518 (“Sugimoto”) in view of U.S. Patent No. 6,354,368 (“Nishishita”). Preliminarily, this rejection is moot with respect to the rejection of claim 25, due to the cancellation thereof. With respect to the remaining claims, however, for all of the arguments previously set forth in the Reply & Amendment filed October 17, 2002 (with respect to applicability of the combination of Sugimoto and Nishishita to claims 1, 2, 4-11 and 13) and for the reasons hereafter set forth, Applicants respectfully continue to traverse this rejection.

**a. Claims 1, 2, and 4-11**

Claim 1 recites (with emphasis added):

... wherein said flat connection part is formed with a third louver in the vicinity of an innermost one of said first louvers, wherein said third louver is *constructed to obstruct a heat transfer in the fin.*

Applicants assert that neither Sugimoto nor Nishishita teaches or suggests each limitation of the recited connection part. However, in rejecting the claims and with respect to the italicized portion of claim 1, the Examiner states: “The functional recitation that ‘constructed to obstruct a heat transfer in the fin’ has not been given patentable weight because it is narrative in form.”

Unlike claim preambles, regardless of whether a limitation in the claim body is functional, it must be given patentable weight, as dictated in M.P.E.P. § 2173.05(g) which provides (with emphasis added): “A functional limitation **must** be evaluated and considered, **just like any other limitation of the claim**, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” For example, § 2173.05(g) sets forth the following phrases which were given patentable weight by the Court of Customs and Patent Appeals (*i.e.*, the predecessor court to the Court of Appeal for the Federal Circuit): “incapable of forming...,” “adapted to be positioned...,” and “being resiliently dilatable...” Clearly, claim 1’s recitation of “constructed to obstruct a heat transfer in the fan” is, therefore, entitled to patentable weight.

In addition, the third louver is positioned in the “vicinity of an innermost one of said first louvers.” This is not merely a design choice. Rather, the third louver is positioned as recited because the heat passing through the second louvers is hotter than that which passes through the first louvers. Having the third louver positioned nearer to the first louvers is advantageous to provide a heat blocking capability to block the hotter heat from getting to the first louvers.

By way of contrast, the folded portion 51/52 in Nishishita, which are positioned at a central region of the heat transfer prevention portion 50, clearly can not serve this heat-blocking feature and, therefore, is not “constructed to obstruct a heat transfer in the fin.” Further, as previously argued, the folded portion 51/52 is constructed such that “the degree to which the dynamic strength of the fin 4 itself becomes reduced in the vicinity of the heat transfer prevention portion 50 can be minimized, and ultimately, the dynamic strength of the fin itself can be preserved.” *See* Nishishita at col. 4, lines 56-60. Clearly, the folded portion

51/52 in Nishishita is provided to reinforce the strength of the fin 4 rather than to serve as a third louver which obstructs heat transfer.

Accordingly, as the Examiner failed to give patentable weight to each limitation of claim 1, the rejection, by its very nature, was erroneous and, therefore, must be withdrawn and the claim properly evaluated in light of the applicable prior art. Finally, as claims 2 and 4-11 depend from claim 1, each of these dependent claims recites the functional limitation to which the Examiner refused to give patentable weight and, therefore, the rejection of these claims was also improper, without regard to the other patentable limitations recited therein. In addition, as the folded portion 51/52 can not, by definition, serve as the recited "third louver," the rejection is plainly wrong for this additional reason. For these reasons, Applicants respectfully request a withdrawal of the rejection of claims 1, 2, and 4-11 under 35 U.S.C. § 103(a).

**b. Claim 13**

As previously stated in the Reply & Amendment filed October 17, 2002, with respect to claim independent 13, Applicants note that the Examiner failed to state how the combination of the Sugimoto and Nishishita taught each limitation of the claim. Presumably, this failure is the direct result of the fact that the combination, in fact, does not teach each limitation of claim 13. In particular, claim 13 recites a "flat connection part arranged between the corrugated first and second parts [which is] formed with a plurality of heat radiation portions." Clearly, the slits S in Sugimoto can not serve as radiators of heat. Further, Nishishita fails to cure the deficiencies of Sugimoto because the *heat transfer prevention* portion 50, by definition, can not qualify as a heat *radiation* portion.

In addition, claim 13, like claim 1 recites functional language to which the Examiner presumably refused to give patentable weight. Specifically, claim 13 recites (emphasis added): "wherein each radiation portion is *constructed not to deteriorate* the heat transfer in the fin substantially." Accordingly, for the reasons previously set forth with respect to claims 1, 2, and 4-11, this functional language must be given patentable weight as dictated by M.P.E.P. § 2173.05(g).

For all of the aforementioned reasons, the combination of Sugimoto and Nishishita fails to teach or suggest each of the limitations of claim 13 and, therefore, the combination can not be used to reject the claim under 35 U.S.C. § 103(a). In addition, in light of the functional language to which the Examiner presumably gave no patentable weight, the rejection was, by its very nature, improper. Therefore, a withdrawal of the rejection of claim 13 under § 103(a) is both warranted and earnestly solicited.

**CONCLUSION**

For the reasons stated above, claims 1, 2, 4-11, and 13 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

June 13, 2003

Date

FOLEY & LARDNER  
Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Phone: (202) 672-5300

Facsimile: (202) 672-5399

Respectfully submitted,

  
Pavan K. Agarwal  
Registration No. 40,888

Frederic T. Tenney  
Registration No. 47,131

SHOULD ADDITIONAL FEES BE NECESSARY IN CONNECTION WITH THE FILING OF THIS PAPER, OR IF A PETITION FOR EXTENSION OF TIME IS REQUIRED FOR TIMELY ACCEPTANCE OF SAME, THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE DEPOSIT ACCOUNT NO. 19-0741 FOR ANY SUCH FEES; AND APPLICANT(S) HEREBY PETITION FOR ANY NEEDED EXTENSION OF TIME.